

### Remarks

This is responsive to the third non-final Office Action mailed August 27, 2004. The Applicant appreciates the detailed review and reasoning provided by the Examiner during the prosecution of this case, and believes a telephonic interview between the Examiner and the Applicant's Attorney would be helpful in resolving the remaining issues relating to the patentability of the claims.

Accordingly, please find submitted herewith a completed form PTOL-413A with a suggested date and time for a telephonic interview. The Examiner is invited to contact the below signed Attorney if another date and time for this requested interview would be more convenient.

### Rejection of Claims Under 35 U.S.C. §102(a)

The Office Action rejected claims 1-3, 5, 7-11 and 13-15 under 35 U.S.C. §102(a) as being anticipated by U.S. Patent No. 6,411,458 issued to Billings et al. ("Billings '458"). This rejection is respectfully traversed.

First, the Applicant points out that Billings '458 does not appear to be available as a prior art reference to the present application under §102(a). The present application was filed November 2, 2001 and has a priority date of April 26, 2001 per U.S. Provisional Patent Application No. 60/286,804.

Billings '458 subsequently issued on June 25, 2002, and thus cannot be viewed as satisfying the "printed publication" requirement of §102(a). The Examiner has further failed to establish a showing that the subject matter of Billings '458 was before the U.S.

public in satisfaction of the "known or used by others" requirement of §102(a). See *Carella v. Starlight Archery & Pro Line Co.*, 804 F.2d 135 (Fed. Cir. 1986).

Reconsideration and withdrawal of the rejection under §102(a) is accordingly solicited on this basis.

However, since Billings '458 might be found to be available as prior art under another section of §102, the Applicant will proceed to discuss the patentability of the claims in view thereof in order to advance the prosecution of the case.

The Applicant maintains that Billings '458 is deficient at least with regard to "scanning consecutive data wedges on a data storage medium for defects by transducing a readback signal from said wedges *beginning at a wedge non-adjacent an angular index reference position...*" (claim 1, lines 1-3).

In establishing the rejection, the Examiner stated that "the location of each data wedge [in Billings '458] is stored in the servo wedge that is associated with [it], making the scanning *capable* of starting at any data wedge on the disk." (Office Action, page 2, lines 14-16, emphasis added). This is respectfully traversed on the basis that this is a minor but important mischaracterization of the disclosure of Billings '458, as well as an unsupportable conclusion drawn therefrom.

Billings '458 discloses a servo format with a "wedge number" field 312 that identifies the sequence number of each servo sector in the sequence around each track. See FIG. 9 and col. 12, lines 21-26 and lines 48-50. Thus, this "wedge number" is actually disclosed as identifying the associated servo sector, not the data wedge that follows it (or the data wedge that precedes it).

The reason this distinction is important is that Billings '458 fails to explicitly disclose initiating the scan beginning at a wedge non-adjacent an angular index reference position, as required by claim 1.

The Examiner has therefore based the rejection on a view that it would be "possible" to start the scan at a wedge non-adjacent the angular index reference position by using the wedge numbers to identify the respective data wedges. This is not, nor ever has been, the test for inherency.

Rather, the test for inherency is as follows: a prior art reference inherently discloses a feature if it is *necessarily present* in the thing described in the reference. See *Schering Corp. v. Geneva Pharmaceuticals, Inc.*, 339 F.3d 1373 (Fed. Cir. 2003); *Toro Co. v. Deere & Co.*, 355 F.3d 1313 (Fed. Cir. 2004). A mere possibility or probability is not enough. *Shering, Supra*; *Toro, Supra*; see also *Continental Can Co. USA v. Monsanto Co.*, 948 F.2d 1264 (Fed. Cir. 1996) (*modified on other grounds*).

Accordingly, the rejection of claim 1 as being anticipated by Billings '458 is improper, and reconsideration and withdrawal of the rejection of this claim, as well as the claims depending therefrom, are respectfully requested.

Since Billings '458 is similarly deficient with regard to the subject matter of independent claim 9, reconsideration and withdrawal of the rejection of claim 9, and the rejection of the claims depending therefrom, are also respectfully requested.

The Applicant further points out that Billings '458 is wholly silent with regard to dependent claim 8, which further generally features the scanning step as "sequentially positioning a data transducer over an initial track to scan the data wedges thereon, *advancing* the data transducer to the next adjacent track and commencing scanning the data

wedges thereon *without waiting for the angular index reference position* to reach the data transducer, and repeating until all of the plurality of concentric tracks on the data storage medium have been scanned.”

As discussed in the specification of the present application at page 10-19, such operation can result in significant time savings on a per-device basis. Billings ‘458 is silent with regard to recognizing this problem, much less disclosing the claimed solution. Accordingly, reconsideration of dependent claim 8, as well as dependent claim 15, are also requested on this basis.

**Rejection of Claims Under 35 U.S.C. 103(a)**

Claims 4, 6 and 12 were rejected under 35 U.S.C. §103(a) as being obvious over Billings ‘458 in view of U.S. Patent No. 5,563,746 issued to Bliss (“Bliss ‘746”). This rejection is traversed on the basis that these claims are patentable as depending from patentable base claims for the reasons set forth above. This rejection is further traversed on the basis that Bliss ‘746, discussed at length in the previous response, adds nothing of significance to make up for the deficiencies of Billings ‘458 with regard to the claimed subject matter.

Accordingly, the Applicant requests reconsideration and the withdrawal of the rejection of these claims under §103(a).

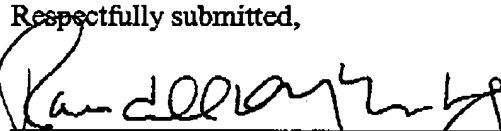
**Conclusion**

The Applicant respectfully requests reconsideration and allowance of all of the claims pending in the application. This is intended to be a complete response to the third non-final Office Action (Paper No. 10) mailed August 27, 2004.

Should any questions arise concerning this response, the Examiner is invited to contact the below signed attorney.

Respectfully submitted,

By



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